

**REMARKS/ARGUMENTS****I. Applicants' Request Reconsideration of Examiner's Decision Regarding the Drawings**

Applicants respectfully request reconsideration of the objection to Figure 1 regarding mounting bracket (32). Mounting bracket (32) is clearly shown in Figure 2 and described in the specification. (See Applicant's specification paragraph [0018]). There is no claim limitation that requires the mounting bracket within the cylindrical housing of cutting head (20) as described in the office action. Figure 1 is merely a schematic illustration of a cutting table incorporating the invention. Figure 2 clearly shows the mounting bracket and provides details of an embodiment of the invention that can be incorporated into a cutting table shown in Figure 1.

The Applicants respectively point out that Figure 2 is not an enlarged view of Figure 1. There is no basis to impose restrictions on Figure 1 to indicate reference (32) when this reference numeral is clearly shown in Figure 2. In Applicants' previous response filed March 8, 2006, it was stated by the applicants that paragraph [0020] of the application notes that reciprocation assembly (130) differs from the reciprocation assembly (30) in that instead of being supported on a mounting bracket the motor is mounted on a return bar (132). Consequently, numerical reference to a mounting bracket (32) was eliminated from Fig. 1.

For the foregoing reasons, it is respectfully submitted that the objection be withdrawn.

## II. Remarks

Claims 1-6 are rejected as being unpatentable over Pearl (US 3,815,221) in view of Henninger (US 3,274,409) and Balamuth (3,086,288) and Kuris (3,610,080). The Examiner stated Pearl discloses all the claimed elements except for the means for actuating the blade or a resonator assembly and a controller. The Examiner further states that Henninger discloses a resonator assembly and Balamuth discloses advantages for using a vibrating blade in cutting operations, particularly for cutting fabrics and leather. The Examiner further states that Kuris claims a controller.

Applicants' traverse the rejection and contend a prima facie case of obvious has not been made. The Applicants' repeat the arguments regarding the references of Pearl, Henninger and Balamuth made in their filed March 8, 2006 response and add the following regarding the reference to Kuris.

Kuris discloses a shaving instrument that is ultrasonically vibrated to reduce frictional resistance of movement of the shaving instrument relative to the skin and a method of shaving. (See e.g., Abstract). Kuris fails to disclose a controller for monitoring vibration of a blade and compensating damping of vibration of the blade by tuning a resonating means. In fact, Kuris teaches away from such a controller by disclosing that the flexural vibrations used in Kuris have nothing to do with cutting because the vibrations are perpendicular to the cutting edge. These vibrations in Kuris are used to reduce friction across the skin. (See, Col. 4, lines 25-33) In contrast, the Applicants invention uses vibrations parallel to the cutting edge. These parallel vibrations in the applicants' invention are used to cut the work material. (See Applicant's

specification paragraph [0019]). Therefore, Kuris can not be used to for monitoring or damping the vibration of the cutting blade as claimed by the Applicants.

Furthermore, the cited reference Kuris is inapposite to the claimed invention and not pertinent to the problem addressed by the applicants. One skilled in the art of cutting sheet type work would not turn to the shaving art to solve problems in the sheet type cutting art. In addition, there is no basis for combining the teachings of these references in the manner described by the Examiner.

Kuris has absolutely no relevance to the problem addressed by the claimed invention, and impermissible hindsight is being used in an attempt to piece together elements of the applicants' claimed invention. It is well settled that it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teachings or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). See also In re Oetiker, supra, 24 U.S.P.Q.2d at 1446; In re Gordon, et. al., 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Moreover, the combination of Pearl and Henninger and Balamuth with Kuris fails because Balamuth discloses an ultrasonically vibrated cutting knife. Using the magnetic power as suggested by the Examiner disclosed in Henninger would result in an apparatus that would not function according to the disclosure in Balamuth that requires

sound waves to function properly. It is well settled that references must be taken in their entireties, including those portions which argue against obviousness. See, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). By combining Henninger that requires magnetism and Balamuth that requires sound waves, the proposed apparatus according to the disclosures of Henninger and Balamuth is inoperable or unable to function for its intended purpose. Such an inoperative product cannot be the basis for a holding of obviousness. In re Sponnoble, 160 U.S.P.Q. 237, 244 (CCPA 1969).

Withdrawal of the rejections and allowance of the claims is respectfully requested. If any issues remain, or if the Examiner has any suggestions for expediting allowance of the application, the Examiner is invited to contact the undersigned attorney.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees that may be required for this response to Deposit Account **13-4500**, Order No. **4757-4142US1**, and is hereby petitioned for any extension of time that may be required to make this response timely. **A DUPLICATE OF THIS SHEET IS ATTACHED.**

Respectfully submitted,  
**MORGAN & FINNEGAN, L.L.P.**



Date: October 5, 2006

By: \_\_\_\_\_

Keith J. McWha  
Registration No. 44,235

Address:

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
Telephone: 212-415-8700  
Facsimile: 212-415-8701

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